Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte STUART RAYMOND PATRICK
and
AMIT CHATTERJEE

_____

Appeal No. 2000-2211
Application 09/031,316

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ON BRIEF

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Before HAIRSTON, GROSS, and SAADAT, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 21 through 25.

The disclosed invention relates to a method for invoking a function to create a device-independent bitmap (DIB).

Claims 21 and 24 are illustrative of the claimed invention, and they read as follows:

21. A method for invoking a function to create a device-independent bitmap, comprising:

(a) issuing, by an application program, a function call of the form CreateDIBSection (a, b, c, d, e, f), wherein a through f are parameters and:

a represents a handle to a device context;

b represents a pointer to a data structure that describes the format of a device-independent bitmap to create;

c represents a value that specifies whether members of the data structure contain explicit color values or palette indices;

d represents a pointer to a buffer that receives the address of the bitmap bits;

e represents an identifier of a memory-mapped object from which the bitmap may be created;

f represents a value that specifies an offset;

(b) receiving, by an operating system, the function call and parsing the call to retrieve the parameters; and

(c) issuing, by the operating system, an acknowledgment to the application program that the function call has been received.

24. A computer readable medium on which is stored an operating system function responsive to a function call from an application program, the function comprising:

a function name CreateDIBSection; and

six function parameters a through f, wherein:

a represents a handle to a device context;

b represents a pointer to a data structure that describes the format of a bitmap to create;

c represents a value that specifies whether members of the data structure contain explicit color values or palette indices;

d represents a pointer to a buffer that receives the address of the bitmap bits;

e represents an identifier of a memory mapped object from which the bitmap may be created; and

f represents a value that specifies an offset.

No references were relied on by the examiner.

Claims 21 through 25 stand rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

Reference is made to the briefs (paper numbers 10 and 12) and the answer (paper number 11) for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will sustain the 35 U.S.C. § 101 rejection of claim 24, and we will reverse the 35 U.S.C. § 101 rejection of claims 21 through 23 and 25.

Turning first to claim 24, the examiner indicates (answer, page 4) that the mere storage of non-functional descriptive material on a computer readable medium does not make it statutory, and that such material standing alone cannot provide a practical application to otherwise non-statutory subject matter.

Appellants argue (brief, page 7) that:

> Claim 24 recites a computer-readable medium (such as memory) storing the unique CreateDIBSection function . . . . As such, the function has a physical presence in memory, which allows its functionality (the function's execution) to be realized by calling it.

Inasmuch as claim 24 is drafted to include only the computer readable medium and its content (i.e., an operating system function referred to by the name of CreateDIBSection, and comprised of six function parameters a through f), and does not include the "function call from an application program," this claim lacks any "functionality" in the absence of a calling by the application program. In the absence of a calling by the application program, we agree with the examiner that the computer readable medium[1] and its content have no practical application. State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998). The content of the computer readable medium remains as "*abstract ideas until reduced to some type of practical application*" by a calling by the application program. AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 56-57, 50 USPQ2d 1447, 1451

[1]In In re Lowry, 32 F.3d 1579, 1581, 32 USPQ2d 1031, 1033 (Fed. Cir. 1994), the content of the computer readable medium was "used by said application program."

(Fed. Cir. 1999). Thus, the 35 U.S.C. § 101 rejection of claim 24 is sustained.

Turning to claims 21 through 23 and 25, we agree with appellants' argument (brief, page 7) that "each recites a process applied to a computer that produces a useful, concrete, and tangible result," namely, the creation of a device-independent bitmap. Unlike claim 24, these claims receive a calling by the application program. Accordingly, the 35 U.S.C. § 101 rejection of claims 21 through 23 and 25 is reversed.

DECISION

The decision of the examiner rejecting claims 21 through 25 under 35 U.S.C. § 101 is affirmed as to claim 24, and is reversed as to claims 21 through 23 and 25.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON Administrative Patent Judge	)	
ANITA PELLMAN GROSS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MAHSHID D. SAADAT Administrative Patent Judge	)	

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